

Application No. 10/779,836
Response Dated 11/13/2006
Reply to Office Action of 08/28/2006
Page 5 of 9

REMARKS:

These remarks are in response to the non-final Office Action mailed 08/28/06, in which claims 1-3, 5-6 and 10-12 are pending, claims 7-9 and 13-20 having previously been withdrawn as being directed to a non-elected species. Claim 4 has previously been canceled.

The Examiner objected to claim 3 because of an alleged informality. This claim has been canceled, consequently this objection is moot.

In the present application, claim 1 is independent and claims 2, 5-6 and 10-11 depend, directly or indirectly from claim 1. Claim 1 has been amended to incorporate recitations from claims 5 and 11 that the micro-shaving element has "a leading surface inclined at an acute first rake angle; and wherein said substrate and said plurality of micro-shaving surfaces are unitary and made from a first material." Support for these amendments can be found in at least claims 5 and 11 as originally filed and in Fig. 1. Claim 1 has also been amended to incorporate the recitation that each micro-shaving defines a cutting edge "for cutting hair from a user's skin during a shaving operation." Support for this amendment can be found in at least the abstract. Claim 1 has further been amended to recite that each micro-shaving element is "arranged transverse to a direction of shaving." Support for this amendment can be found in Fig. 1 and paragraph [0008] of the specification. No new matter was added in making these amendments. Claims 5 and 11 have been amended to remove the recitations previously described that were incorporated into claim 1. Claims 3 and 12 have been canceled.

The Examiner rejected claims 1, 5, 6 and 11 under 35 U.S.C. 102(b) as being anticipated by Capps (5,533,894).

The disclosure of Capps is directed to an equine dental float which is used to file the teeth of horses to remove projecting edges. For a rejection to be made under 35 U.S.C 102, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Claim 1 has been amended as previously described. The Applicants contend that Capps fails to disclose, teach or suggest

Application No. 10/779,836
Response Dated 11/13/2006
Reply to Office Action of 08/28/2006
Page 6 of 9

"a leading surface inclined at an acute first rake angle," "said substrate and said plurality of micro-shaving surfaces are unitary" and "for cutting hair from a user's skin during a shaving operation" as recited in pertinent part in claim 1. The Applicants respectfully traverse Examiner's statement that "[t]he blades of Capps are capable of shaving as claimed." As previously mentioned, the disclosure of Capps is directed to an equine dental float which is used to file the teeth of horses to remove projecting edges. This is not "shaving" as used in the context of the present application which is the operation of cutting hair from a user's skin. The object of the operation of shaving, in the context of the present application, is to remove hair from a user's (non-rigid) skin surface without excessively damaging the skin surface. The float of Capps is intended to file an entire hard or rigid projection, ie a tooth. The Applicants therefore believe that claim 1 is allowable over Capps. Claims 5, 6 and 11, being dependent on claim 1 are also allowable and the Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 1, 5, 6 and 11 under 35 U.S.C. 102(b) as being anticipated by Capps.

The Examiner rejected claims 1, 2, 5, 6 and 11 under 35 U.S.C. 102(b) as being anticipated by Dischler (6,216,561).

The disclosure of Dischler is directed to "safety razor heads having an intrinsically fenced unitary blade oriented at a high slicing angle to the direction of shaving" and in particular "oriented at an angle greater than 30 degrees." The Applicants contend that Dischler fails to disclose, teach or suggest that each micro-shaving element is "arranged transverse to a direction of shaving" and that each micro-shaving element defines a cutting edge thereof "for *cutting* hair from a user's skin" (emphasis added) as recited in claim 1. The blade edges of the device of Dischler are arranged at a high slicing angle and are intended to slice hair. One of skill in the art of the present invention would understand "slicing" to be an entirely different action to "cutting" where the cutting edge contacts the hair transversely to the direction of shaving and has no lateral, or slicing, motion. In fact Dischler teaches away from cutting in a transverse direction, or "chopping" as Dischler calls this, in at least Col 1, lines 19-28 therein, stating:

The advantages of using blades with a slicing rather than chopping motion have been known for hundreds, perhaps thousands of years. One has but to cut a loaf of bread

Application No. 10/779,836
Response Dated 11/13/2006
Reply to Office Action of 08/28/2006
Page 7 of 9

to immediately realize that a slicing motion cuts cleaner and with less tearing. The most immediate advantage for the blade is the reduction of force that is required for cutting, reducing wear and tear on the cutting edge. For a shaver, it is perhaps more important that the cutting force applied to the follicles be reduced, producing a less painful shaving experience.

The Applicants therefore believe that claim 1 is allowable over Dischler. Claims 2, 5, 6 and 11, being dependent on claim 1 are also allowable and the Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 1, 2, 5, 6 and 11 under 35 U.S.C. 102(b) as being anticipated by Dischler.

The Examiner rejected claim 2 under 35 U.S.C. 103(a) as being allegedly unpatentable over Capps as applied to claim 1 above, and further in view of Davison et al (4,625,725), hereinafter Davison.

For at least the reasons mentioned previously, the Applicants contend that Capps fails to disclose, teach or suggest the cited recitations of claim 1 and thus dependent claim 2. The disclosure of Davison is directed to a surgical rasp for scraping and reshaping bones, particularly in cosmetic surgery. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The Applicants contend that Capps and Davison, individually or in combination fail to disclose, teach or suggest "at least one longitudinal micro-shaving element defines a substantially triangular cross section having a leading surface inclined at an acute first rake angle" and a cutting edge "for cutting hair from a user's skin during a shaving operation" as recited in claim 1 and thus dependent claim 2 of the present application. The Applicants therefore contend that claim 2 is allowable and respectfully requested the Examiner to reconsider and withdraw the rejection of claim 2 under 35 U.S.C. 103(a) as being obvious over Capps in view of Davison.

Application No. 10/779,836
Response Dated 11/13/2006
Reply to Office Action of 08/28/2006
Page 8 of 9

The Examiner rejected claims 3 and 12 under 35 U.S.C. 103(a) as being allegedly unpatentable over Capps as applied to claims 1 and 11 above, and further in view of Polk et al (3,940,293), hereinafter Polk and as being allegedly unpatentable over Dischler as applied to claims 1 and 11 above, and further in view of Polk.

These rejections are moot in light of the cancellation of these claims.

The Examiner rejected claim 10 under 35 U.S.C. 103(a) as being allegedly unpatentable over Capps as applied to claim 1 above, and further in view of Orloff (5,983,756).

For at least the reasons mentioned previously, the Applicants contend that Capps fails to disclose, teach or suggest the cited recitations of claim 1 and thus dependent claim 10. The disclosure of Orloff is directed to a method for forming a blade having circular apertures with sharpened edges utilizing electro-chemical machining. The Applicants contend that Capps and Orloff, individually or in combination fail to disclose, teach or suggest a micro-shaving element "a plurality of longitudinal micro-shaving elements projecting outwardly from a surface of said substrate, said micro-shaving elements being arranged in at least one row with each micro-shaving element being spaced away from and approximately parallel to the next successive micro-shaving element and arranged transverse to a direction of shaving" as recited in claim 1 and thus dependent claim 10 of the present application. The Applicants therefore contend that claim 10 is allowable and respectfully requested the Examiner to reconsider and withdraw the rejection of claim 10 under 35 U.S.C. 103(a) as being obvious over Capps in view of Orloff.

The Examiner rejected claim 10 under 35 U.S.C. 103(a) as being allegedly unpatentable over Dischler as applied to claim 1 above, and further in view of Orloff.

For at least the reasons mentioned previously, the Applicants contend that Dischler fails to disclose, teach or suggest the cited recitations of claim 1 and thus dependent claim 10. The disclosure of Orloff has been previously described. The Applicants contend that Dischler and Orloff, individually or in combination fail to disclose, teach or suggest each micro-shaving element is "arranged transverse to a direction of shaving" as recited in claim 1 and thus dependent claim 10 of the present application. In fact, as argued previously, Dischler

Application No. 10/779,836
Response Dated 11/13/2006
Reply to Office Action of 08/28/2006
Page 9 of 9

RECEIVED
CENTRAL FAX CENTER

NOV 13 2006

teaches away from this claimed recitation. The Applicants therefore contend that claim 10 is allowable and respectfully requested the Examiner to reconsider and withdraw the rejection of claim 10 under 35 U.S.C. 103(a) as being obvious over Dischler in view of Orloff.

SUMMARY:

In summary, the Applicants believe that the foregoing remarks are fully responsive to the Office Action and that the amended claims herein are allowable. The Applicants therefore respectfully request that the rejection and objection be withdrawn and the present application be passed onto allowance.

The Applicants believe that no additional fees are due with the filing of the present response, however, if any additional fees are due, please charge Deposit Account No 503342 maintained by the Attorneys of the Applicants.

Respectfully submitted,

By 
David C. Coffin
Registration No. 57,908

Michaud-Duffy Group LLP
CenterPoint
306 Industrial Park Road, Suite 206
Middletown, CT 06457-1532
Tel: (860) 632-7200
Fax: (860) 632-8269